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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,641

09/20/2007

Thomas Falck

DE03 0356 US1

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7590

12/31/2009

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

KELLEY, STEVEN SHAUN

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

12/31/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/575,641	Applicant(s) FALCK ET AL.	
	Examiner STEVEN KELLEY	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art, how to make and/or use the invention. There is no support in the specification for the features relating to “exchanging the independent sections,” as now recited in claim 1. For example, the specification teaches that each partner transmits their own (different) independent sections not the same sections (which is required by antecedent basis of “the independent sections”). In other words, “mutually exchanging the independent sections” describes the scenario where user A transmits data to user B and then user B transmits the same data back to user A, which is not supported by the specification.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 as the claimed invention is directed to non-statutory subject matter. Claims 1-9 are rejected under 35 U.S.C. 101 as not

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falling within one of the four statutory categories of invention. Supreme Court precedent and recent Federal Circuit decisions indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claims recite a series of steps or acts to be performed, the claims neither transform underlying subject matter nor positively ties to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process. For example, claim 1 which recites “segmenting the information into several independent sections, and mutually exchanging the independent sections step by step between at least two partners using communication devices”, is of sufficient breadth that it would be reasonably interpreted as steps which may be completely performed (mentally, verbally and/or without a machine) by a person(s), as the phrase “using communication devices” may be interpreted to apply to the “partners” and not to the “step by step exchange”. For example, “transmitting information, using a first communication device, to a second communication device”, positively recites that the step of transmitting is performed by the communication device.

As written, the steps of claim 1 may be performed by two people sitting across a table from each other (where the partners are talking on cell phones to other parties, (recited “partners using communication devices”)), where each person has a piece of paper containing their personal information (or a picture of themselves), the piece of paper is cut into small square sections (segmented into several independent sections)

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and each section is passes across the table (exchanged step by step) to the other person.

Similarly, all the features recited claims 2-9 may be performed (mentally, verbally, etc.) by people, and do not recite any structures and do not recite transforming underlying subject matter to a different state, therefore the recited method steps read on a process which may be performed by a person. For example, in the above scenario, the two people may (perform the steps of) agreeing on the grid size (as recited in claim 5), deciding to abort exchange (as recited in claim 8) and transmitting all the remaining sections at once (as recited in claim 9), without the use of any device.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 7,401,098 to Baker (hereinafter "Baker") in view of U.S. Patent Pub. 2002/0184153 to De Vries (hereinafter "De Vries").

Regarding claim 1, Baker teaches a "chat room" system which employs methods that may be used in a mobile phone environment (see Fig. 8). As described in column

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4, lines 1-13, Baker teaches that “Criteria such as personal interests, hobbies, geographic location, age group... may be compiled into a list and revealed graphically, to other chatters in a visual display window”. This mutual exchange of personal information (segmented into criteria as mentioned above) in Baker reads on the language recited in claim 1, however, Baker does not explicitly teach that the “segmented (personal) information is exchanged step by step”.

In an analogous art, De Vries teaches a system which compares personal information between parties, where each comparison of interests compares a “segment of the information”, as recited. De Vries teaches (see step 310 in Fig. 3) comparing (step by step) this stored personal information to another party’s information. See also sections [0059]-[0064] for the description of Fig. 3.

Therefore, as both Baker and De Vries are concerned with partial revealing of information (to protect the individual), it would have been obvious to one of ordinary skill in the art to modify the system of Baker to partially mutually exchange information (“step by step” as taught by De Vries) in order to protect as user from revealing all their personal information, as is conventional.

Regarding claim 2, which recites “wherein the information is converted into a graphics display before segmentation and transmission”, see column 4, lines 1-13 of Baker which teach that the information is “revealed graphically”, as recited.

Regarding claim 3, which recites “wherein the segmentation and the exchange of information take place in such a way that each information unit provides for itself an

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information contribution recognizable to the user”, as each segmented section of data in Baker is an interest criteria, these segments “provide for itself an information contribution recognizable to the user”, as recited.

Regarding claim 4, which recites “wherein the graphics display of the information is divided into rows and columns, so that a matrix of n times m -fields is formed”, inherently all information displayed on a display screen is divided in to rows and columns, as recited.

Regarding claim 5, which recites “wherein the grid of the matrix is agreed upon by the partners before segmentation of the information”, as Baker teaches chatting with family members or friends, if the two partners are using the same device (with the same size of display), “the grid of the matrix is agreed upon”, as recited.

Regarding claim 6, which recites “wherein the grid of the matrix is standardized”, if the two partners are using the same device (with the same size of display), “the grid of the matrix is standardized”, as recited.

Regarding claim 7, which recites “wherein each information fragment has its position in the matrix attached to it”, as each segmented section of data in Baker is an interest criteria, these segments may displayed in a specific place on the display, therefore each segment must inherently have “its position in the matrix attached to it” so it may be properly displayed.

Regarding claim 8, which recites “wherein the information exchange can be aborted by either partner at any time”, any partner exchanging information in Baker may abort information exchange at any time”, as recited.

Regarding claim 9, which recites “wherein the information sections not yet transmitted can be transmitted in one step at any time”, it would have been obvious to one of ordinary skill to modify Baker/De Vries combination to transmit “all sections remaining”, once trust has been established between the chatters, as is conventional.

6. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kelley whose telephone number is (571) 272-5652. The examiner can normally be reached on Monday-Friday, 9AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SSK/

/LESTER KINCAID/

Supervisory Patent Examiner, Art Unit 2617